IN THE

Supreme Court of the United States

October Term, 1968

No. 1127

TECHNITEOL, INC.,

Petitioner,

vs.

HONORABLE EDWARD J. McMANUS, United States District Judge For the Northern District of Iowa, Cedar Rapids Division,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE EIGHTH CIRCUIT AND APPENDIX

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Petitioner (Plaintiff below) Technitrol, Inc. (Technitrol) respectfully prays that a Writ of Certiorari issue to the United States Court of Appeals for the Eighth Circuit to review a Judgment of that Court entered December 24, 1968, denying Technitrol's Petition for a Writ of Mandamus, pursuant to Title 28, U. S. Code, Section 1651 and Rule 21 of the Federal Rules of Appellate Procedure, directing Honorable Edward J. McManus, Judge of the United States District Court for the Northern District of Iowa, Cedar Rapids Division

(1) to vacate an Order entered by him on August 14, 1968, in *Technitrol, Inc.* v. *Collins Radio Company* v. *Ex-Cell-O Corporation,* Civil Action No. 68-C-

5CR, denying a Motion of Technitrol to Remand or Retransfer that case to the Northern District of Georgia, Atlanta Division; and

(2) to order the case transferred to the Northern District of Georgia, Atlanta Division.

This case deals in general with the question of which Court should review an executed order of transfer of venue under Title 28 U. S. Code, Section 1404(a).

I—OPINIONS BELOW

The Opinion of the Court of Appeals below appears at page A1* and is not yet reported. The Opinion of Judge McManus of the District Court of Iowa appears at page A-12 and is unreported. The Opinion of Judge Sidney O. Smith, Jr. of the District Court for the Northern District of Georgia appears at page A-15 and is unreported.

II—JURISDICTION

The Judgment of the Court below was entered December 24, 1968.

The jurisdiction of this Court is invoked under Title 28, U. S. Code, Section 1254(1) (62 Stat. 928) and Title 28, U. S. Code, Section 2101(c) (63 Stat. 104); and under Rule 22(3) of the Rules of this Court.

No Petition for Rehearing was filed in the Court below and there has been no extension of time for filing this Petition.

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*Herein the following abbreviations are used:
A — Appendix to this Petition
PEX — Petitioner's Exhibit filed with its Petition to the Court of Appeals for the Eighth Circuit for a Writ of Mandamus.
REX—Respondent's Exhibit filed in Opposition to the foregoing Petition for a Writ of Mandamus.

III—REASONS RELIED UPON FOR GRANTING THE WRIT

1. The Court of Appeals below has rendered a decision in conflict with a decision of another Court of Appeals on the same matter and in conflict with procedures tacitly approved by this Court in *Hoffman* v. *Blaski et al.* (1960) 363 US 335.

2. The Court of Appeals below has decided an important question of Federal Law which has not been, but should be, explicitly settled by this Court.

IV—QUESTIONS PRESENTED FOR REVIEW

The questions presented are:

(1) Where, in response to a motion to transfer an action under Title 28, U. S. Code, Section 1404(a), an order is entered allowing the motion and where the records in the case are physically transferred by the Clerk to the transferee Court, all prior to notice to the parties, precluding reconsideration by the transferor Court or review by its Court of Appeals, and where a motion to remand or retransfer to the transferor Court is then filed in the transferee Court and denied by that Court on the ground that determination of the question of venue under Section 1404(a) would constitute "a usurpation of appellate function and interference with orderly judicial process", is it the duty of the Court of Appeals of the transferee Circuit on a petition for writ of mandamus to review the order of the transferor Court on the merits?

(2) Where, in response to a motion to transfer an action under Title 28, U. S. Code, Section 1404(a), an order is entered allowing the motion and where the records in the case are physically transferred by the Clerk to the transferee Court, all prior to notice to the parties, precluding reconsideration by the transferor Court or review by its Court of Appeals, and where a motion to remand or retransfer to the transferor Court is then filed in the trans-

feree Court, would an independent determination of the question of venue under Section 1404(a) by the transferee Court constitute "a usurpation of appellate function and interference with orderly judicial process"?

(3) Where, in response to a motion to retransfer an action to the Court from which it has been transferred upon a motion under Title 28, U. S. Code, Section 1404(a), does an order of the transferee Court denying such motion on the ground that determination of the question of venue under Section 1404(a) would constitute "a usurpation of appellate function and interference with orderly judicial process", represent such a refusal by the transferee Court to exercise its discretion as effectively to constitute a "clear abuse of discretion"?

(4) Where, on a motion to transfer an action under Title 28, U. S. Code, Section 1404(a) for the convenience of the parties and witnesses and in the interest of justice, an order is entered granting or denying the motion, is the availability of review of the order on appeal from a final judgment an adequate remedy to the parties concerned and a ground for refusing a petition for a writ of mandamus by the losing party?

V—STATUTES INVOLVED

This Petition involves a consideration of the following statutes:

Title 28, U. S. Code

§ 1400. Patents and copyrights

(b) Any civil action for patent infringement may be brought in the judicial district where the defendant resides, or where the defendant has committed acts of infringement and has a regular and established place of business. (62 Stat. 936)

Title 28, U. S. Code

§ 1404. Change of venue

(a) For the convenience of parties and witnesses, in the interest of justice, a district court may transfer any civil action to any other district or division where it might have been brought. (62 Stat. 937)

Title 28, U. S. Code

§ 1406. Cure or waiver of defects

(a) The district court of a district in which is filed a case laying venue in the wrong division or district shall dismiss, or if it be in the interest of justice, transfer such case to any dstrict or division in which it could have been brought. (62 Stat. 937; 63 Stat. 101)

Title 35, U. S. Code

§ 271. Infringement of patent

(a) Except as otherwise provided in this title, whoever without authority makes, uses or sells any patented invention, within the United States during the term of the patent therefor, infringes the patent.

(b) Whoever actively induces infringement of a patent shall be liable as an infringer. (66 Stat. 811)

Code of Georgia, Sec. 109A-2-401 (Uniform Commercial Code, Sec. 2-401) Passing of Title

Unless otherwise explicitly agreed title passes to the buyer at the time and place at which the seller completes his performance with reference to the physical delivery of the goods, despite any reservation of a security interest and even though a document of title is to be delivered at

a different time or place; and in particular and despite any reservation of a security interest by the bill of lading

(a) if the contract requires or authorizes the seller to send the goods to the buyer but does not require him to deliver them at destination, title passes to the buyer at the time and place of shipment; but

(b) if the contract requires delivery at destination, title passes on tender there.

VI—STATEMENT OF THE CASE

At the outset, it is believed that a brief chronological outline of the prior proceedings in this case would be helpful. This controversy arises from an Action entitled *Technitrol, Inc.* v. *Collins Radio Company,* Civil Action No. 11165, filed in the Northern District of Georgia on August 25, 1967, (PEX 2) charging infringement by Collins Radio Company (Collins) of Patent No. 2,611,813 owned by Technitrol and directed to a complex Magnetic Data Storage System (PEX 3-1, Exhibit 1). One example of the use of the inventions of this patent is in an airlines reservation system. The Action was brought in Georgia because the principal accused infringing system was one sold by Collins to Delta Airlines (Delta) and assembled, installed, and tested by Collins there and operated by Delta there with Collins' assistance (Yuter Aff., PEX 3-1, Paras. 4, 7, 8; Hopkins Aff., PEX 6, Paras. 3, 4).

The federal jurisdiction of the District Court of Georgia in the Action described was based on Title 28, U. S. Code, Section 1400(b) (p. 4) and Title 35, U. S. Code, Section 281.

Rather than answering the Complaint, Collins, on October 27, 1967, filed a Motion to Transfer that Action to the Northern District of Iowa under Title 28, U. S. Code, Sections 1404 and 1406 (p. 5) for the convenience of

the parties, in the interest of justice, and because of alleged improper venue (PEX 4). In support of its allegation of improper venue, Collins' patent counsel, in a supporting Affidavit, represented that the Collins-supplied data system of Delta, though located in Georgia, was not made, used, or sold by Collins in Georgia (Phillion Aff., PEX 5, Para. 13).

That Motion was briefed by the parties and, while it was pending before the Georgia Court, Technitrol, on January 10, 1968, noticed the deposition of a number of Delta officers and personnel for February 8, 1968, and by a subpoena *duces tecum* commanded one representative of Delta to produce all contracts relating to the Collins-supplied Delta system (PEX 7, Exhibits A and B). This was the earliest date convenient to all parties concerned. The purpose of such depositions and subpoena, *inter alia,* was to determine the extent of the infringing acts of Collins in Georgia and, thus, to discover facts peculiarly within the knowledge of Collins and Delta relevant to the basis of the Collins Motion to Transfer.

Judge Smith of the Georgia Court was specifically advised of these pending depositions by a letter dated January 10, 1968, and was requested to delay his decision "until after the depositions have been filed and considered by the Court" (PEX 16, Hopkins Aff. and Exhibit A).

Notwithstanding such request and the pendency of such discovery depositions, on January 30, 1968, the Honorable Sidney O. Smith, Jr., United States District Judge for the Northern District of Georgia, entered an Order (PEX 8) transferring the case to the Northern District of Iowa and directing the Clerk to transmit the files *forthwith.* The Clerk thereupon did transfer the files forthwith and *prior to notice* to Technitrol (Yuter Aff., PEX 3-1, Para. 9; Hopkins Aff., PEX 9, Para. 2).

On February 8, 1968, at the deposition of Delta employee James W. Callison, after objection by Collins'

counsel and upon request of Collins' counsel, Mr. Callison refused to produce the basic agreement between Collins and Delta relating to the Collins-supplied Delta system on the claim of irrelevance (PEX 7, Exhibit C).

On March 10, 1968, Technitrol filed its Motion for an Order to Show Cause (PEX 7) why Mr. Callison should not produce the basic agreement. On May 8, 1968, after a hearing of such Motion, the basic Agreement of November 4, 1963 (PEX 3-2, Exibit 6) was produced. This Agreement confirms the assertions in the Yuter and Hopkins Affidavits to the effect that Collins both *used* and *sold* its magnetic data storage system in Georgia. The basic Agreement provides that Collins "* * * will install the System at a site provided by Delta. * * * Upon acceptance of the System by Delta, following installation and checkout of the System" by Collins, Collins "will sell the System to Korda. * * * Immediately after said sale, Korda, as lessor, and Delta, as lessee, will enter into a lease of the System. * * *" (Yuter Supp. Aff., PEX 3-2, Para. 21). The sale and lease took place on the same day (Yuter Aff., PEX 3-1, Para. 7). Collins has not denied that the lease was made at Delta's offices in Atlanta, Georgia, where the System was then located.

Upon receipt of the Court records in this case by the Clerk of the Court for the Northern District of Iowa, the case was docketed there on or about February 1, 1968, as Civil Action No. 68-C-5CR.

Thereafter, on February 12, 1968, in the Iowa case, Collins filed a Complaint against Ex-Cell-O Corporation (Ex-Cell-O) as Third-Party Defendant (PEX 10), alleging that Ex-Cell-O had agreed to indemnify Collins against infringement by reason of Ex-Cell-O's sale to Collins of sub-systems charged to infringe the patent in suit.

On February 23, 1968, Collins filed an Amended Answer to the Complaint, including a Counterclaim, (PEX 11) charging Technitrol with violation of the Antitrust Laws.

Based on evidence obtained in the aforesaid depositions of Delta personnel on February 8, 1968, (and subsequent to Judge Smith's Order of January 30, 1968) that Ex-Cell-O and Delta also infringed the patent in suit in Georgia, *Technitrol* filed a Complaint against *Collins, Ex-Cell-O and Delta* in the Northern District of Georgia, Civil Action No. 11596 (PEX 3-1, Exhibit 2, the Georgia case), charging Defendants with infringing the Technitrol Patent 2,611,813 and also asserting that Technitrol is a third-party beneficiary of agreements on the part of Collins and Ex-Cell-O to hold Delta harmless against infringement of such patent by Delta.*

On April 25, 1968, in the Iowa case, Technitrol filed a Motion to Remand or Retransfer the case to the Northern District of Georgia (PEX 13) on the grounds that (1) new evidence, developed after the case was transferred, showed that the Georgia Court was misled as to the venue of the Georgia Court by the erroneous Phillion Affidavit filed by Collins (PEX 5, Para. 13); (2) the new development of an antitrust counter claim against Technitrol shifted the balance of convenience in favor of Georgia; and (3) the Iowa case should be consolidated with the Georgia case, including Delta as a Defendant, in order that Technitrol could obtain complete relief, since the Action against Delta could not have been brought in Iowa.

On June 3, 1968, Judge Smith, in the Georgia case, ordered a stay of proceedings in that case until final disposition of Technitrol's Motion to Remand or Retransfer in the Iowa case.

On August 14, 1968, in an Order in the Iowa case (PEX 1), Judge McManus denied Technitrol's Motion to Remand or Retransfer on the ground that "to entertain such a

*Technitrol could not use such new evidence as a basis for requesting Judge Smith to reconsider his Order of January 30, 1968, or as a basis of a Petition for a Writ of Mandamus to the Court of Appeals for the Fifth Circuit since all of the Court records in the instant case had been physically transferred to the Iowa Court. (See A21-A25)

determination would be tantamount to reviewing Judge Smith's Order of January 30, 1968, thus constituting a usurpation of appellate function and interference with orderly judicial process * * *."

Thus Technitrol continued to be deprived of the right of review of the Georgia Court's Transfer Order, which Order was based on erroneous sworn statements in the Phillion Affidavit filed by Collins.

On September 17, 1968, Technitrol filed in the Court of Appeals for the Eighth Circuit its Petition for a Writ of Mandamus to Judge McManus, requesting that he vacate his Order of August 14, 1968, (PEX 1) denying Technitrol's Motion to Remand or Retransfer the case to the Northern District of Georgia, Atlanta Division, and order the case transferred to the Georgia Court.

On December 24, 1968, the Court of Appeals for the Eighth Circuit rendered an Opinion denying Petitioner's Writ of Mandamus, essentially on the following grounds:

> 1. That Judge McManus' "ruling on the transfer order, as is the situation with interlocutory orders generally, remains open for consideration upon appeal from final judgment. ***" (A-8)
>
> 2. That the new evidence adduced by Technitrol after Judge Smith's Order of January 30, 1968 (PEX 1), "bears almost wholly upon the question of whether venue exists in Georgia" while Judge Smith, in the Georgia Action, rested his Order upon the convenience of the parties. (A-9)
>
> 3. That Judge McManus was correct "in stating that entertaining the motion would be tantamount to reviewing Judge Smith's order". (A-9)

The facts relating to the merits of the transfer issue are briefly as follows:

Collins *made* in Georgia (by reassembling separately shipped components and completing their connections into a system with other components) the accused Delta $1.8 million magnetic data storage system (Yuter Aff., PEX 3-1, Para. 7; Yuter Aff., PEX 3-2, Para. 21). Collins *used* its magnetic data storage system in Georgia for a check-out period of 10-12 days before the sale in order to demonstrate to Delta that the system was acceptable (Yuter Aff., PEX 3-1, Para. 7). Furthermore, Collins *sold* the Delta system in Georgia. The bill of sale was signed on June 15, 1964, in Dallas, Texas (Yuter Aff., PEX 3-1, Para. 7, Exhibit 3). Collins has insisted that such bill of sale was delivered to Korda, the lessor, in New York and that therefore the sale of the Delta magnetic data storage system was made in New York. However, the Code of Georgia, Section 109A-2-401 (*supra,* pp. 5-6); Uniform Commercial Code, Section 2-401) expressly negates the place of delivery of a document of title as a factor in determining the place of sale. Moreover, Collins currently is, and has been for a number of years, servicing and maintaining the magnetic data storage system for Delta (Yuter Aff., PEX 3-1, Para. 7; Yuter Aff., PEX 3-2, Para. 21; Hopkins Aff., PEX 6, Para. 3). Collins has admitted that it has two regular and established places of business in Atlanta, in the Northern District of Georgia* (Phillion Aff., PEX 5, Para. 3). Consequently, it is clear that venue over the instant Action lies in the Northern District of Georgia where Collins has made, used, sold, and induced Delta to use the accused Delta magnetic data storage system.

On the principal issue of infringement of the accused Delta magnetic storage system, all of the records describing this system are in Georgia, where they are required

*Collins alleges that these places of business do not satisfy the requirements of Title 28, U. S. Code, Section 1400(b) (p. 4) because its activities are not related to the accused infringing system. However, the statute includes no limitation as to the nature of the activities of the regular places of business and, understandably, Collins has been able to cite no authority in support of its novel contention.

in order to maintain and repair the system (Yuter Aff., PEX 3-1, Para. 4). Delta has, in addition, coupled the Collins magnetic data storage system with equipment supplied by the American Telephone & Telegraph Company and by International Business Machines Corporation to form a communications system and this combination infringes certain claims of the patent in suit not infringed by Collins. The basic records of this Delta communications system are all in Georgia, not in Iowa (Yuter Aff., PEX 3-1, Paras. 2-4; Yuter Aff., PEX 3-3, Para. 22).

Collins has raised the issue of title to, and development of, the inventions claimed in the patent in suit (Relson Aff., REX IA, Paras. 4 to 8). The witnesses on these issues are in Philadelphia, Pennsylvania and the related documents are in Philadelphia or at the office of Technitrol's trial attorney in New York City (Yuter Aff., PEX 3-1, Para. 10).

The substance of Collins' Antitrust Counterclaim (PEX 11) concerns certain statements made by the inventors to the U. S. Patent Office during the prosecution of the patent application which matured into the patent. These statements were made under the direction of Technitrol's former patent attorneys, then as now located in Philadelphia. Thus Technitrol's witnesses are in Philadelphia and the related documents are located in Philadelphia or in Technitrol's trial counsel's offices in New York City (Yuter Aff., PEX 3-1, Para. 11).

The trial counsel of Collins, Darby & Darby, are also located in New York City. Philadelphia and New York are both substantially closer to Atlanta, Georgia than to Cedar Rapids, Iowa, where the case is now pending. Moreover, air travel between Atlanta on the one hand and New York, Philadelphia on the other hand, is faster, more frequent, and more convenient than that between Cedar Rapids and New York, Philadelphia (Hopkins Aff., PEX 6, Paras. 5 to 8).

The case of *Technitrol* v. *Ex-Cell-O, Collins and Delta,* Civil Action No. 11596, (Yuter Aff., PEX 3-1, Exhibit 2) now pending in the Northern District of Georgia, embraces all of the issues of infringement asserted by Technitrol. The consolidation of the instant case with that case would resolve all of the issues without wasteful duplication of judicial time. That case could not have been brought in Iowa where Delta has no established place of business and has committed no acts of infringement and for that reason it cannot be transferred there. Georgia is the *only* jurisdiction where *all* of the issues of infringement and validity of the patent in suit and the antitrust issues raised by Collins can be resolved in a single trial.

In brief, this Action was commenced as a straightforward Action for infringement of Technitrol's patent in the jurisdiction where the principal accused apparatus is located at Delta Airlines, where Collins has infringed the patent, and where it has established places of business. In the all-too-common practice of "forum shopping", Collins moved to transfer the Action to the District Court in its "home town" of Cedar Rapids, Iowa.

Pending the depositions of Delta Airlines personnel to establish certain of the facts on which venue rested under Title 28, U. S. Code, Section 1400(b), of which the Georgia Court was advised, and pending the development of facts relating to the convenience of the parties and the interest of justice under Title 28, U. S. Code, Section 1404(a), the Court granted Collins' Motion and directed the Clerk to transfer the case *forthwith,* which the Clerk did *prior to notice* to the parties. This precluded Technitrol from seeking reconsideration of Judge Smith's Order after the facts were fully developed by the depositions of the Delta Airlines employees and further precluded Technitrol from seeking review from the Court of Appeals for the Fifth Circuit. The Court of Appeals below criticized this peremptory transfer of the case, saying:

> "• • • It would appear to be the better procedure to hold up the transfer for a reasonable time pending possible petition for reconsideration or review. • • •" (A-3 - A-4)

Technitrol then moved in the Iowa Court for a remand or retransfer of the case back to the Georgia Court, citing the additional evidence obtained during the Delta Airlines depositions and the wrongful withholding of the critical Collins-Delta Sales Agreement, both of which showed that there was actually no sound basis for ordering a transfer of the Action from Georgia to Iowa.

Judge McManus of the Iowa Court denied the Technitrol Motion to remand or retransfer, resting his decision solely on his reasoning:

> "• • • It is the view of the court that to entertain such a determination would be tantamount to reviewing Judge Smith's order of February 1, 1968, thus constituting a usurpation of appellate function and interference with orderly judicial process. • • •". (A-14)

Believing that Judge McManus had an erroneous view of the law applicable to such a Motion to Retransfer, Technitrol filed its Petition for a Writ of Mandamus in the Court of Appeals for the Eighth Circuit. As pointed out below, the Court of Appeals below bottomed its Opinion on rationale in conflict with decisions of the Courts of Appeals of other Circuits.

VII—ARGUMENT

General

The foregoing factual summary forms the basis for the four questions presented for review (*supra,* pp. 3-4). Thus, Judge McManus of the Iowa Court reasoned that if he remanded the case to Georgia, he would be usurping an

"appellate function" by reviewing the decision of Judge Smith of the Georgia Court. The Court of Appeals below tacitly approved this holding, *even disregarding the additional critical evidence developed after* Judge Smith's Decision, for it said:

> "We believe that Judge McManus was justified in stating that entertaining the motion would be tantamount to reviewing Judge Smith's order. In our view, a necessary implication from such determination is that Judge McManus determined that the record on transfer before him was not significantly different from the record considered by Judge Smith. * * *" (A-9)

Questions (1) and (2) (*supra*, pp. 3-4) relate to the correctness of these holdings of the Trial Court and the Court of Appeals below. The applicable law is discussed hereinafter (pp. 20-24).

Further, the reasoning of Judge McManus forms the basis of the third question above, namely, whether such refusal to exercise his independent judgment and discretion effectively constituted "a clear abuse of discretion". The Court of Appeals recognized that mandamus will lie to correct "a clear abuse of discretion", citing *A. Olinick* v. *Dempster* (CA 2, 1966) 365 F. 2d 439 (A-6). In that case, plaintiff-petitioner purchased a scrap metal processing equipment from defendant but claimed that the equipment was defective and brought suit for damages. Defendant moved to transfer the case under Section 1404(a) from the Eastern District of New York to the Eastern District of Tennessee, which motion was granted by the Trial Court with certification to the Court of Appeals for the Second Circuit under Title 28, U. S. Code, Section 1292(b). Plaintiff then filed in the Court of Appeals for the Second Circuit both an interlocutory appeal under Section 1292(b) and a petition for a writ of mandamus.

The Court of Appeals concluded that the interlocutory appeal procedure was not available in that case, and exhaustively analyzed the authorities dealing with review of transfer orders by way of mandamus and held:

> "* * * The Courts of Appeals understandably wish to reserve power to redress *clear-cut abuses of discretion* in the handling of § 1404(a) motions, since such abuses cause great inconvenience and expense to the litigants and are almost impossible to correct by review after trial. * * *" (Page 444; emphasis added)

The Court of Appeals then thoroughly examined the merits of the motion to transfer and denied mandamus on the sole ground "* * * We cannot hold that the trial Court's decision to transfer the present case * * * was a clear-cut abuse of discretion."

The Court of Appeals of the Third Circuit has equated failure of a district court to exercise discretion with abuse of discretion. Thus, in *Paramount Pictures et al.* v. *Rodney* (1951) 186 F.2d 111, all of the defendants in two civil antitrust actions moved to transfer them from the District of Delaware to an appropriate district court in Texas. Judge Rodney denied the motions and defendants filed petitions for mandamus in the Third Circuit Court of Appeals which granted the writs, saying:

> "* * * The Delaware district court possesses the power to transfer the causes but has refused to exercise that power because it believes it does not possess it. Mandamus is the proper remedy. Cf. Perkins v. Elg, 307 U. S. 325, 59 S.Ct. 884, 83 L.Ed. 1320. The writ is as appropriate to compel the exercise of discretion as it is to correct the abuse of discretion. * * *" (p. 116)

It is submitted that the rulings of Judge McManus and of the Court of Appeals below constituted a refusal to

exercise independent judgment and discretion and effectively constituted "a clear abuse of discretion" within the rulings of *A. Olinick* v. *Dempster* and *Paramount Pictures et al* v. *Rodney* (*supra.* pp. 15-16).

The fourth question presented is raised by the holding of the Court below:

> "The ruling on the transfer order, as is the situation with interlocutory orders generally, remains open for consideration upon appeal from final judgment. * * *" (A-8)

This holding overlooks the basic difference between orders transferring an action for the convenience of the parties and in the interest of justice and other interlocutory orders.

It was so held by the Court of Appeals for the Third Circuit in *Paramount Pictures et al.* v *Rodney (supra,* p. 16) in which, in granting writs of mandamus, the Court said:

> "* * * As was pointed out in Ford Motor Co. v. Ryan, 2 Cir., 182 F.2d 329, 330, the order would '* * * probably be incorrectible on appeal [after final judgment], for petitioners could hardly show that a different result would have been reached had the suit been transferred.' * * *" (p. 116)

The same Court, in *Gulf Research* v. *Schlumberger* (CA 3, 1951) 193 F. 2d 302, held that the granting or denial of an order on a motion for transfer for the convenience of the parties and witnesses and in the interest of justice is *not* like other interlocutory orders because, if the trial is conducted in the wrong forum, the adverse results (increased costs, inconvenience to the parties and witnesses, and/or delay) will have been realized by the time the trial is completed and cannot be redressed by a second trial in the right forum. Thus, the opinion of the Court states:

> "* * * Those cases, however, have all involved transfers under Sec. 1404(a) of Title 28, U.S.C., the forum non conveniens section. As we pointed out in Pennsylvania Turnpike Commission v. Welsh, 1951, 188 F. 2d 447, 449 footnote 2, these cases normally deal with an issue, the convenience of parties and witnesses, 'which in its nature must be reviewed before trial, if at all.' * * *"

To the same effect is *A. Olinick* v. *Dempster, supra* (p. 15) in which the Court held that the trial court's abuse of discretion in ruling on a motion for transfer under Section 1404(a) would:

> "* * * cause great inconvenience and expense to the litigants and are almost impossible to correct by review after trial. * * *" (Page 444)

Further, in *Magnetic Engineering* v. *Dings* (CA 2, 1949) 178 F. 2d 866, cited by the Court below (A-4), Judge Frank, in a dissenting opinion, called attention to the fact that the right of review of a transfer order after trial and final judgment does not provide appellant adequate relief because:

> "* * * I think, therefore, that a sense of justice should prompt us to grant relief, if possible, by way of mandamus. * * * For if, on the facts here, the transfer order was improper, plaintiff may be seriously hurt, should he be obliged to wait, for a vacation or reversal of that order, until the completion of a trial in Wisconsin. Indeed, paradoxically, if he must thus wait, and then wins at the end of the trial, *the hurt to him, caused by the transfer, will be wholly irremediable.*" (Page 870; emphasis added)

Thus the above-quoted holding of the Court below is in conflict with opinions of the Courts of Appeals of the Second and Third Circuits.

The Opinion of the Court below contains several other errors and omissions which, for the sake of coherence, are discussed in the Appendix. Briefly stated, it is submitted that the Court below erred in the following respects:

(1) It erroneously attributed to Technitrol an inexcusable delay of "more than seven months" in filing its Petition for a Writ of Mandamus. Actually, this period was consumed in necessary proceedings between the Order of Judge Smith of January 30, 1968 (PEX 8) and the filing of the Technitrol Petition for a Writ of Mandamus on September 17, 1968. In addition settlement negotiations between the parties were proceeding during a substantial portion of this period and the parties agreed to suspend activity.* (Yuter Aff. PEX 3-2, Paras. 13 to 16 and Exhibits 4 and 5). (A-25 - A-26)

(2) It erroneously overlooked the statements in Judge Smith's Order of January 30, 1968, (PEX 8) which indicated that his decision on the question of transfer for the convenience of the parties under Section 1404(a) was persuaded by his doubts as to the propriety of the venue of the Georgia Court under Section 1406 (A-26 - A-28).

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*The Opinion of the Court of Appeals below is capable of interpretation to mean that Technitrol should have sought review of Judge Smith's Order of January 30, 1968 (PEX 8) directly by that Court rather than by filing its Motion to Remand or Retransfer (PEX 13) in the District Court of Iowa, charging Technitrol, *inter alia*, with the four-month period that Judge McManus had under advisement such Motion of Technitrol. Such an interpretation seems to be supported by the statement of the Court:

> "Judge Smith's transfer order is not, as we have hereinabove stated, directly before us for review. * * *" (A-10)

The reference to the previous statement appears to be to the paragraph including the statement

> "* * * No effort was made to invoke our jurisdiction prior to the September 17, 1968, petition for mandamus. * * *" (A-4)

Such an interpretation seems incredible but, if this is what the Court below meant, it was clear error of law. *Preston et al.* v. *Raese* (CA 4, 1964 335 F. 2d 827 (*infra*, p. 23).

(3) It erroneously implied that Technitrol could have and should have sought review of Judge Smith's Order of January 30, 1968, (PEX 8) by reconsideration or by the Court of Appeals for the Fifth Circuit, even though the transfer of the case to the Iowa Court was completed before Technitrol was notified of the Order (A-21 - A-25).

POINT 1—The Court of Appeals Below, in Holding that the Transferee Court of Appeals Should Not, as a Matter of Law, Review on the Merits an Order of a Transferor Court, Has Rendered a Decision in Conflict with Decisions of the Court of Appeals of the Second Circuit.

The Court of Appeals below, in its Opinion, recognized this conflict:

> "The Seventh and Fourth Circuits have held that they have no jurisdiction to consider the propriety of an order of transfer made by a district court of another circuit. *Purex Corp.* v. *St. Louis Nat'l Stockyards Co.*, 7 Cir., 374 F. 2d 998, 1000; *Preston Corp.* v. *Raese*, 4 Cir., 335 F 2d 827, 828. The Second Circuit has held that the writ must be reviewed if at all by the circuit to which the case is transferred. *Magnetic Eng'r & Mfg. Co.* v. *Dings Mfg. Co.*, 2 Cir., 178 F. 2d 866, 869-70." (A-4)

Considering first the *Magnetic Engineering* case, plaintiff brought an action in the Southern District of New York for an order enjoining defendant from threatening plaintiff's customers and for other relief. The Trial Court, *inter alia*, denied plaintiff's demand for a preliminary injunction and granted defendant's motion for transfer under Section 1404(a) to the Eastern District of Wisconsin. Plaintiff appealed to the Second Circuit Court of Appeals, at which time the Court records had not been physically transferred to the Wisconsin Court. However, the records were transferred during the pendency of the appeal.

The Court, through Judge Learned Hand, held that while such a transfer order usually is not appealable, in the instant case it would be futile to remand the case to the Trial Court since it was too late for plaintiff to seek review of the transfer order by mandamus "* * * for the cause has been already transferred". Therefore, to do justice, the Court ignored "what is, at best, only a matter of form" and treated the appeal as a petition for a writ of mandamus.

The Court then denied mandamus solely on the ground that the merits of the transfer order should be reviewed by way of a motion to remand in the transferee District Court which, if denied, should be followed by an application for a writ of mandamus in the Court of Appeals of the transferee Circuit, saying:

> "* * * There are therefore at least plausible grounds why we should issue the writ. On the other hand, whatever power of review we may have, the Court of Appeals for the Seventh Circuit has the same; and that court will be in a much better position than we to pass upon at least the first of the two questions involved; *i. e.,* the extent to which any review of the transfer will be open upon appeal from a final judgment against the plaintiff. It is true that the same considerations would determine the answer, whether we, or the Seventh Circuit, decide it; but it does not follow that the decision would be the same in each court; and, since the absence of any relief upon appeal from final judgment is so critical in the decision, surely it is appropriate for that court to decide it, which will decide the appeal itself. * * *" (Pages 869-870)

The Second Circuit Court of Appeals has consistently followed the rule of the *Magnetic Engineering* case in *Arrowhead* v. *The Aimee Lykes et al.* (1951) 193 F. 2d 83 and *Anthony* v. *Kaufman* (1951) 193 F. 2d 85. The *Arrow-*

head case was an admiralty action in libel in the Southern District of New York which, on the motion of respondent, was transferred to the District of Alabama. Plaintiff then filed an appeal which the Court, through Judge Frank, treated as a mandamus petition and then denied the petition, saying:

> "* * * Yet if no more than 'abuse' of discretion is involved, and the order directs a transfer, we have held that we will not entertain such a petition, for it must be addressed to the court of appeals for the circuit which includes the transferee district." (p. 84, citing *Magnetic Engineering*)

The opinion in the *Anthony* case was issued the same day as in *Arrowhead* and involved similar facts. The Court of Appeals denied the petition for mandamus on the authority of the *Magnetic Engineering* case.

The Court of Appeals below explicitly declined to review on the merits the correctness of the Order of Judge Smith of the District Court of Georgia granting Collins' Motion to Transfer, saying:

> "Judge Smith's transfer order is not, as we have hereinabove stated, directly before us for review. * * *" (A-10)

This ruling is squarely in conflict with the *Magnetic Engineering, Arrowhead,* and *Anthony* cases, (*supra*, pp. 20-22).

On the other hand, the Fourth and Seventh Circuit cases cited by the Court below (A-4) in reality do not support its position. In *Purex et al.* v. *St. Louis National Stockyards* (CA 7, 1967) 374 F. 2d 998 (cert. den. 389 US 824), plaintiffs-appellants brought an action in the Eastern District of Missouri against a warehouseman to recover for goods lost in a fire. Defendant moved under Section 1404(a) to transfer the case to the Eastern District of Illinois, which motion was granted. The case was

tried in the Illinois Court and resulted in a judgment on the merits in favor of defendant. Plaintiffs then appealed to the Seventh Circuit Court of Appeals on the ground, *inter alia,* that they had been prejudiced by transfer of the action to the Illinois Court and sought an order remanding the case to the Missouri Court for a new trial.

The Seventh Circuit Court of Appeals denied this request and affirmed the judgment of the Trial Court, saying:

> "Inasmuch as the complaint of plaintiffs is actually directed against the action of the transferor court which sits in the eighth judicial circuit, and as *the record fails to show that plaintiffs made, in the transferee court in Illinois, any motion to retransfer* the case to St. Louis, we have no jurisdiction to act extra-territorially in order to adjudicate the question now raised by plaintiffs. (Emphasis added)
>
> * * * * * * * * *
>
> "It appears to us that the Court of Appeals of the Eighth Circuit has ample jurisdiction, whether by mandamus or other remedy, if not by appeal, to adjudicate the validity of the transfer order. We do not have that jurisdiction." (Page 1000)

Thus the rejection of jurisdiction by the Seventh Circuit Court of Appeals was basically on the ground that plaintiffs had failed to file "any motion to retransfer the case to St. Louis". That is not the situation here where Technitrol did file just such a Motion in the Iowa Court.

The case of *Preston et al.* v. *Raese* (CA 4, 1964) 335 F. 2d 827, was a bill in the nature of an interpleader brought in the Southern District of Florida. That Court granted defendant's motion to transfer the case to the Northern District of West Virginia under Section 1404(a) and the relevant records "were immediately forwarded to

the Clerk of that Court". Plaintiffs then filed a petition for a writ of mandamus in the Court of Appeals for the Fifth Circuit, seeking to vacate the transfer, but the petition was denied.

After the transfer, no motion was filed in the West Virginia Court to remand the case to Florida but, instead, plaintiffs filed an appeal to the Fourth Circuit Court of Appeals from what they termed "certain findings" contained in the order of the Florida Court. The Fourth Circuit Court of Appeals held that the order of the Florida court was not appealable but added by way of dictum:

> "* * * But even if such an order were appealable the appropriate appellate court would be the Fifth, not the Fourth, Circuit. The attempt here is to appeal to us from an order entered by a District Court not within our territorial jurisdiction. We know of no authority permitting us to entertain such an appeal."

Thus, the decision of the Court of Appeals below stands alone and in conflict with the only other appellate decisions found dealing squarely with the issue (*supra,* pp. 20-22).

POINT 2—The Court of Appeals Below has Decided an Important Question of Federal Law Which has Not Been, but Should Be, Settled by This Court.

In effectively holding that a transfer order under Section 1404(a) should not be reviewed by the tranferee Court or its Appellate Court on mandamus, the Court of Appeals below not only rendered a decision in conflict with the decisions in *Magnetic Engineering* v. *Dings, Arrowhead* v. *The Aimee Lykes et al,* and *Anthony* v. *Kaufman* (*supra,* pp. 20-22) but also in conflict with procedure tacitly approved by this Court in *Hoffman* v. *Blaski et al.* (1960) 363 US 335.

That case involved a patent infringement action by plaintiffs, *Blaski et al.*, residents of Illinois, against *Howell et al.*, residents of Dallas, Texas, brought in the Northern District of Texas. Defendants moved under Section 1404(a) to transfer the case to the Northern District of Illinois on the ground that that Court would be more convenient to the parties and the witnesses and that it would be in the interest of justice because several actions involving the same patents were then pending in the latter Court. Defendants also stated that, if the case were transferred, they would waive all objections to the venue of the Illinois Court. Plaintiffs objected to the transfer on the ground that the action could not have been brought in Illinois because that Court had no personal jurisdiction over defendants. The District Court ordered the transfer without consideration of plaintiffs' objection. Plaintiffs thereupon filed a petition for a writ of mandamus in the Fifth Circuit Court of Appeals which denied the petition on the ground that:

> "• • • '(t)he purposes for which Sec. 1404(a) was enacted would be unduly circumscribed if a transfer could not be made "in the interest of justice" to a district where the defendants not only waive venue but to which they seek the transfer,'. Ex parte Blaski, 245 F. 2d 737, 738."

Upon transfer of the case to Illinois and its assignment to Judge Hoffman, plaintiffs promptly moved for an order remanding the case to Texas on the ground that the Texas Court did not have the power to make the transfer order and that hence the Illinois Court was not vested with jurisdiction. Judge Hoffman expressed the view that reason and logic favored retransfer of the case to Texas and, with misgivings, denied the motion. Plaintiffs then filed a petition for a writ of mandamus in the Seventh Circuit Court of Appeals which granted the writ on the ground that:

> "• • • '(w)hen Congress provided [in Sec. 1404(a)] for transfer [of a civil action] to a district "where it might have been brought," it is hardly open to doubt but that it referred to a district where the plaintiff • • • had a right to bring the case,' and that respondents did not have a *right* to bring this action in the Illinois district. • • •" (Emphasis Court's)

With respect to the propriety of the motion to retransfer the action to Texas, this Court said:

> "• • • No claim is made here that the order of the Fifth Circuit denying the motion of respondents in the Blaski case for leave to file a petition for writ of mandamus, 245 F. 2d 737, precluded Judge Hoffman or the Seventh Circuit from remanding that case. • • •"

On certiorari, this Court elaborated on this point extensively and concluded by approving of the propriety of the retransfer proceedings in the Illinois District Court and the Seventh Circuit Court of Appeals, saying:

> "• • • When, therefore, jurisdiction of the District Court was assailed in the Seventh Circuit by the petition for mandamus, that court surely had power to determine whether it would hold, on such an appeal, that the Illinois District Court did or did not have jurisdiction of the action and, if not, to say so and thus avoid the delays and expense of a futile trial." (f.n. 9)

Thereupon, this Court affirmed the Seventh Circuit Court of Appeals and ordered the retransfer of the action to Texas.

Thus, the decision of the Court of Appeals below, effectively declining to review on the merits Judge Mc Manus' denial of Technitrol's Motion to Remand to the

Georgia Court, is not in accord with the implicit ruling of this Court in the *Hoffman* v. *Blaski et al.* case.

VIII—CONCLUSION

It is submitted that the decision of the Court of Appeals below is in conflict with decisions of the Court of Appeals of the Second Circuit with respect to the right of a Court of Appeals of the transferee Circuit to review on the merits a transfer order issued by the transferor court and that that decision is further in conflict with an implicit ruling of this Court in the decision of *Hoffman* v. *Blaski et at.* (1960) 363 US 335.

Respectfully submitted,

LAURENCE B. DODDS,
Attorney for Petitioner.

S. C. YUTER
Counsel for Petitioner.

APPENDIX

UNITED STATES COURT OF APPEALS
FOR THE EIGHTH CIRCUIT

No. 19,447.

Technitrol, Inc.,
Petitioner,

v.

Honorable Edward J. McManus, United States District Judge for the Northern District of Iowa, Cedar Rapids Division,
Respondent.

On Petition for Writ of Mandamus.

[December 24, 1968.]

Before VAN OOSTERHOUT, Chief Judge; MEHAFFY and HEANEY, Circuit Judges.

VAN OOSTERHOUT, Chief Judge.

On September 17, 1968, Technitrol, Inc. (Technitrol), petitioned this court pursuant to 28 U.S.C.A. § 1651 and Rule 21 of the Federal Rules of Appellate Procedure for a writ of mandamus directed to the Honorable Edward J. McManus, District Judge for the Northern District of Iowa, requiring Judge McManus to vacate an order he entered on August 14, 1968, in *Technitrol, Inc.* v. *Collins Radio Company (Collins)*, denying a motion by Technitrol to remand or retransfer the case to the Northern District of Georgia, Atlanta Division.

This court by order dated September 20, 1968, directed respondents to answer and fixed time for briefing. Briefs have been filed and the mandamus case has been orally argued and submitted to us.[1]

The case involved in this proceeding is a complex patent infringement suit commenced by Technitrol against Collins on August 25, 1967, in the United States District Court at Atlanta. Technitrol seeks relief in the form of an injunction and damages. Collins on October 26, 1967, filed a motion in the Georgia Court to transfer the case to the Northern District of Iowa, Cedar Rapids Division, based on convenience and justice under 28 U.S.C.A. § 1404(a), and upon failure to comply with venue requirements under 28 U.S.C.A. § 1406.

The transfer issue was heard and determined in Georgia by Judge Smith after full consideration of extensive affidavits and briefs filed by the opposing parties. A comprehensive order directing the transfer on the ground of convenience and justice was filed on February 1, 1968. In such order, Judge Smith compliments counsel on their thorough and energetic efforts in presenting the questions raised by the motion. He lists the factors to be considered in a § 1404(a) motion, as set out in *Gulf Oil Corp.* v. *Gilbert,* 330 U.S. 501, and other cases, and sets forth his findings with respect to such factors, including a finding reading:

> "Accordingly, the strong ties to Cedar Rapids when compared with the tenuous connection with this forum both as to the element of convenience of the parties and the separate element of the interests of justice support the transfer to the Cedar Rapids forum. . . ."

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[1] While Judge McManus is named as the only respondent in the caption, Rule 21 provides that all parties below other than the petitioner shall also be deemed respondents for all purposes. The burden of briefing and argument on behalf of all respondents has been assumed by counsel for Collins.

Judge Smith in his order states that the issue of venue in Georgia is hotly contested and that litigation of the venue issue might result in a significant delay and added expense, and that the better course is to remit the parties to a district where there is no doubt as to venue. Judge Smith makes it clear that he is not resting his ruling on the venue ground by stating: "The Court does not deem it necessary to rest this transfer upon that ground and this order should not be construed as a ruling for or against the contention as to improper venue."

Judge Smith further points out that there is a likelihood of a speedier trial in Iowa as the weighted case load there is substantially lower than that in Georgia.

Pursuant to such order, the files in the case were immediately transferred to the Iowa court and received there on February 1, 1968.

No attempt was made by Technitrol to obtain reconsideration of the transfer order, to take an interlocutory appeal from the Georgia order under 28 U.S.C.A. § 1292 (b),[2] nor was mandamus relief sought from the Fifth Circuit.

Technitrol states it had no opportunity to apply to the Georgia court for reconsideration or to the Fifth Circuit for relief because jurisdiction was lost by the immediate transfer of the case out of the circuit. It would appear to be the better procedure to hold up the transfer for a reasonable time pending possible petition for reconsidera-

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[2] The Fifth Circuit has expressed the view that an order transferring venue should be attacked by a § 1292(b) proceeding rather than by mandamus. *Humble Oil & Refining Co.* v. *Bell Marine Service, Inc.*, 5 Cir., 321 F.2d 53. The Eighth Circuit discusses the § 1292 (b) remedy in *Evans Elec. Const. Co.* v. *McManus*, 8 Cir., 338 F.2d 952, 953. Other circuits have held the § 1292(b) relief inappropriate. See *A. Olinick & Sons* v. *Dempster Bros. Inc.*, 2 Cir., 365 F.2d 439, 442-43, and cases there cited. It is unnecessary for the purpose of the disposition of this case for us to determine the appropriateness of the § 1292(b) remedy.

tion or review. We believe that it is highly probable that if Judge Smith had been timely advised of Technitrol's desire to appeal or seek mandamus, he could and would have requested and received a return of the papers from Iowa with an appropriate order of retransfer if such is required. See and compare *Swindell-Dressler Corp.* v. *Dumbauld,* 3 Cir., 308 F.2d 267; *Panhandle Eastern Pipe Line Co.* v. *Federal Power Comm'n,* 8 Cir., 343 F.2d 905, 908-09.

In *I-T-E Circuit Breaker Co.* v. *Becker,* 8 Cir., 343 F.2d 361, we reviewed by mandamus the validity of an order of transfer in a situation where the case had already been transferred to and accepted by the Illinois Federal District Court.

The Seventh and Fourth Circuits have held that they have no jurisdiction to consider the propriety of an order of transfer made by a district court of another circuit. *Purex Corp.* v. *St. Louis Nat'l Stockyards Co.,* 7 Cir., 374 F.2d 998, 1000; *Preston Corp.* v. *Raese,* 4 Cir., 335 F.2d 827, 828. The Second Circuit has held that the writ must be reviewed if at all by the circuit to which the case is transferred. *Magnetic Eng'.r & Mfg. Co.* v. *Dings Mfg. Co.,* 2 Cir., 178 F.2d 866, 869-70.

While we have grave doubt whether we have any right to review the validity of a transfer order made by a federal District Court outside the circuit, we deem it unnecessary to resolve such question here. No effort was made to invoke our jurisdiction prior to the September 17, 1968, petition for mandamus. This was more than seven months after the Georgia transfer order. Such an unreasonable delay standing alone is a sufficient basis for our refusal to exercise our discretionary power to entertain the writ so far as it pertains to relief from the Georgia transfer order.

The issue remains whether Technitrol is entitled to the writ of mandamus prayed for which would direct

Judge McManus to vacate his order of August 14, 1968, denying Technitrol's motion to remand or retransfer the case to Georgia and whether Judge McManus should be ordered to transfer the case to Georgia.

We shall review the governing law with respect to the circumstances under which a writ of mandamus may be granted. In *McGraw-Edison Co.* v. *Van Pelt,* 8 Cir., 350 F.2d 361, this court en banc held that a court of appeals possesses the power to issue a writ of mandamus under extraordinary circumstances to correct a § 1404(a) transfer order. We emphasized, however, that we were not opening the door to any loose issuance of the writ and that the traditional restraint must be exercised by an appellate court in relation to the issuance of any writ:

> "The only relief which a party will be permitted to seek in such a situation is against manifest judicial arbitrariness. Unless it is made clearly to appear that the facts and circumstances are without any basis for a judgment of discretion, the appellate court will not proceed further to examine the district court's action in the situation. If the facts and circumstances are rationally capable of providing reasons for what the district court has done, its judgment based on those reasons will not be reviewed. *Chemetron Corporation* v. *Perry,* 295 F.2d 703, 704 (7 Cir. 1961). Where basis exists for judgment of discretion, the appellate court may not substitute its own discretion for that of the district court." 350 F.2d 361, 363.

In that case, we held that the record supplied a reasonable basis for the exercise of discretion by the trial court and we denied the petition.

In *Evans Elec. Const. Co.* v. *McManus,* 8 Cir., 338 F.2d 952, 953-54, we held:

> "Primarily, the 'use of the writ [of mandamus] in aid of appellate jurisdiction both at common law and in the federal courts has been to confine an inferior court to a lawful exercise of its prescribed jurisdiction or to compel it to exercise its authority when it is its duty to do so.' *Roche* v. *Evaporated Milk Ass'n,* 319 U.S. 21, 26, 63 S.Ct 938, 941, 87 L.Ed. 1185 (1943).
>
> "Resort to the writ beyond this use should be permitted only in 'extraordinary causes'—generally speaking, 'only where appeal is a clearly inadequate remedy.' *Ex parte, Fahey,* 332 U.S. 258, . . ."

In *A. Olinick & Sons* v. *Dempster Bros., Inc.*, 2 Cir., 365 F.2d 439, 443-44, the court cites many cases from various circuits dealing with the availability of mandamus, and then states: "What emerges from a review of the cases is a strong sense of appellate reluctance to interfere with the District Court's exercise of its discretion under 28 U.S.C. § 1404(a)." The court goes on to hold that an appellate court should not review the record de novo; that mandamus does not lie to review mere error but only to redress a clear abuse of discretion; that the Second Circuit has never overturned a transfer order for abuse of discretion and that other courts have done so infrequently and then only in the most clear-cut cases.

In *Will* v. *United States,* 389 U.S. 90, the government obtained a writ of mandamus from the Seventh Circuit vacating an order of the district judge requiring the government to provide defendant with certain information. The Court observes that the parties devoted substantial argument to the propriety of the district judge's order. The Court finds that it is unnecessary to reach such question, stating among other things:

> "The peremptory writ of mandamus has traditionally been used in the federal courts only 'to confine an inferior court to a lawful exercise of its

prescribed jurisdiction or to compel it to exercise its authority when it is its duty to do so.' *Roche* v. *Evaporated Milk Assn.*, 319 U.S. 21, 26 (1943). While the courts have never confined themselves to an arbitrary and technical definition of 'jurisdiction,' it is clear that only exceptional circumstances amounting to a judicial 'usurpation of power' will justify the invocation of this extraordinary remedy.''

• • • • • • • • •

''And the party seeking mandamus has 'the burden of showing that its right to issuance of the writ is ''clear and indisputable.'' '

• • • • • • • • •

''Thus the most that can be claimed on this record is that petitioner may have erred in ruling on matters within his jurisdiction. See *Parr* v. *United States*, 351 U.S. 513, 520 (1956). But '[t]he extraordinary writs do not reach to such cases; they may not be used to thwart the congressional policy against piecemeal appeals.' *Id.*, at 520-521. Mandamus, it must be remembered, does not 'run the gauntlet of reversible errors.' *Bankers Life & Cas. Co.* v. *Holland*, 346 U.S. 379, 382 (1953). Its office is not to 'control the decision of the trial court,' but rather merely to confine the lower court to the sphere of its discretionary power. *Id.*, at 383.'' 389 U.S. 90, 95, 96, 103-04.

See *American Flyers Airline Corp.* v *Farrell*, 2 Cir., 385 F.2d 936.

Technitrol's first attack upon the transfer order was made by a motion to remand and retransfer, filed in the Iowa court on April 25, 1968, nearly three months after the Georgia court's transfer order. In the meantime, Collins had filed an answer to the complaint and an amendment to answer and counterclaim, asserting antitrust violations, and had brought in a third-party defendant,

whom Collins claimed had agreed to indemnify it. Technitrol had filed a second complaint in Georgia, reiterating substantially the claims asserted in the first complaint, and joining additional defendants. Motions to dismiss and stay were filed and the action was subsequently stayed pending the resolution of the Iowa retransfer motion.

The present petition of mandamus was filed September 17, 1968, some thirty-three days after the Iowa court's order, and thirteen months after the original action was commenced. It would clearly appear that the continuation of the transfer proceedings would further unduly delay the already long delayed trial on the merits and would not be in the interest of justice and would thwart the congressional policy against unreasonable delay in litigation by means of piecemeal appeals.

The ruling on the transfer order, as is the situation with interlocutory orders generally, remains open for consideration upon appeal from final judgment. *Southern Railway Co.* v. *Madden,* 4 Cir., 235 F.2d 198, 200; see *Evans Elec. Const. Co.* v. *McManus,* supra; *Carr* v. *Donohoe,* 8 Cir., 201 F.2d 426.

The motion to remand asserts three grounds, to-wit: (1) New evidence in support of venue in Georgia. (2) New developments found in the amended answer and counterclaim shift the balance of convenience in favor of the Georgia court. (3) Retransfer would permit the consolidation of this case with the new case brought in Georgia making Delta Airlines a party. Additional affidavits were filed and the issues presented by the motion were briefed. On August 14, 1968, Judge McManus filed an order denying the motion, stating:

> "It is the view of the court that to entertain such a determination would be tantamount to reviewing Judge Smith's order of February 1, 1968, thus constituting a usurpation of appellate founction and in-

terference with orderly judicial process. *Devex Corp.* v. *General Motors Corp.*, 263 F.Supp. 17, 23 (D.Del. 1967); *Gulf Research & Development Co.* v. *Schlumberger Well Surveying Corp.*, 98 F. Supp. 198, 201 (D.Del. 1951), mandamus denied sub nom. *Gulf Research & Development Co.* v. *Leahy*, 193 F.2d 302 (3d Cir. 1951), aff'd 344 U.S. 861 (1952)."

In our view, the new grounds asserted and the additional affidavits filed have little bearing upon the issue of transfer of venue under § 1404(a). The new evidence bears almost wholly upon the question of whether venue exists in Georgia. Such new evidence is controverted. As previously pointed out, Judge Smith specifically disclaimed basing the transfer upon improper venue in Georgia. There is little if any evidentiary support for the contention that the new issues and new parties brought into the controversy create any material change in the balance of convenience issue. No reasonable explanation appears why Technitrol did not bring in Delta in the original action if it wished to include that company as a defendant.

We believe that Judge McManus was justified in stating that entertaining the motion would be tantamount to reviewing Judge Smith's order. In our view, a necessary implication from such determination is that Judge McManus determined that the record on transfer before him was not significantly different from the record considered by Judge Smith. Such a determination is fully warranted by the record.

In Gulf Research & Development Co., cited by Judge McManus, the Delaware trial judge determined that although he might have power to review the transfer order of California Judge Harrison, he did not deem it proper to do so, basing his decision upon the following reasoning:

"To do so would be a usurpation of an appellate function; and on at least one other occasion I have

refused to so act. Though counsel for plaintiffs and defendant have addressed themselves both in their briefs and oral argument to the merits of Judge Harrison's holding on the venue question, all of the contentions on the merits were before Judge Harrison. It is now for an appellate court—not for me—to correct any error, if error there be in his opinion. It is not only the principle of comity and the fact that Judge Harrison's opinion may be likened, at this stage, to the 'law of this case' which compels me to this conclusion, but, what seems of most importance to me are considerations for the orderly functioning of the judicial process. If I should grant plaintiffs' motion and say, in effect, to Judge Harrison, 'You were wrong in transferring this case to Delaware,' I do not think he, in turn, would be any more bound to take and try the case on the merits, thereby respecting my views, than I had shown myself to be in ignoring his considered judgment. If both Judge Harrison and I were obdurate in our positions, this case could conceivably shuttle back and forth interminably between California and Delaware. Such an eventuality should be avoided." 98 F.Supp. 198, 201.

The Third Circuit denied mandamus on the ground that there were no extraordinary circumstances which called for resort to mandamus. The Supreme Court affirmed, by an equally divided court. 344 U.S. 861. See *Rinaldi* v. *The Elisabeth Bakke,* N.D.Cal., 107 F.Supp. 975, 976; *Devex Corp.* v. *General Motors Corp.,* D.Del., 263 F.Supp. 17, 23; 1 Moore's Federal Practice ¶0.145[4.-4]; 1A Moore's Federal Practice ¶0.404[8].

Judge Smith's transfer order is not, as we have hereinabove stated, directly before us for revie The record before Judge Smith and his transfer order were before Judge McManus at the time that he issued the order deny-

ing the retransfer. It appears to us that Judge Smith's order is a well-reasoned order which sets forth proper legal standards and sets out evidentiary support for the findings made. It is our view that Judge McManus was justified in exercising his discretion by refusing to redetermine the same issue which had been fully considered and resolved by Judge Smith upon substantially the same record.

Moreover, an appellate court is vested with a large discretion of its own in determining whether a writ of mandamus should be granted. In our view, Technitrol has not on the record before us met the heavy burden resting upon it to establish that its right to the issuance of the writ is clear and indisputable.

The petition for mandamus is denied.

A true copy.

Attest:

Clerk, U. S. Court of Appeals, Eighth Circuit.

IN THE

UNITED STATES DISTRICT COURT

FOR THE NORTHERN DISTRICT OF IOWA

CEDAR RAPIDS DIVISION

TECHNITROL, INC., *Plaintiff,* v. COLLINS RADIO COMPANY, *Defendant and Third Party Plaintiff,* v. EX-CELL-O CORPORATION, *Third Party Defendant.*	CIVIL NO. 68-C-5-CR ORDER

This matter is before the court on a multitude of motions, requests, extensions of time and resistances, the last being filed August 5, 1968.

In this action plaintiff (Technitrol), seeks damages and injunctive relief for patent infringement against defendant Collins Radio Company (Collins). Collins counterclaims for a declaration of patent invalidity and damages for alleged antitrust violations. In its third party complaint, Collins further seeks a declaration of liability, indemnification and damages against Ex-Cell-O Corporation (Ex-Cell-O), who in turn counterclaims against Technitrol for a declaration of invalidity and non-infringement. The case is currently before this court pursuant to order of transfer of the Honorable Sidney O. Smith, Jr. of the United States District Court for the Northern District of Georgia, Atlanta Division, filed February 1, 1968.

MOTION FOR DEFAULT JUDGMENT

Ex-Cell-O seeks a default judgment on its counterclaim for declaratory judgment against Technitrol. In its motion filed June 6, 1968, it is contended that default judgment should be entered on the ground that plaintiff failed to reply to its counterclaim. It is the view of the court that this motion is not well taken for the reason that no reply to a third party answer containing a counterclaim is required. F.R.C.P. 7(a); 2A Moore ¶7.04 at 1539 (2d ed. 1968); and, therefore, all averments in the last pleading are deemed denied. F.R.C.P. 8(d); 2A Moore ¶7.04 at 1540 (2d ed. 1968).

MOTION FOR STAY

Collins, on May 6, 1968, filed a motion to stay decision on Technitrol's motion to retransfer or remand this case back to the Northern District of Georgia, Atlanta Division. The ground asserted for staying that decision is that a second action (Civil Action No. 11596) involving essentially the same issues and subject matter, but including one additional defendant, Delta Airlines, is now pending in the Atlanta Division. That court, by order of June 3, 1968, has stayed action on a motion to transfer the second case to this District until this court's decision on the motion to retransfer or remand (infra).

To grant the motion to stay would serve only to further protract the ultimate determination of the issues involved here. Therefore, it is the view of the court that Collins' motion for stay should be denied.

REQUEST FOR LEAVE TO REPLY

Collins' Request for Leave to File a Reply to Plaintiff's Reply Memorandum on Motion to Remand or Retransfer filed July 24, 1968, is granted for the reason that the court deems it desirable to have before it all possible considerations relative to this matter.

MOTION TO REMAND OR RETRANSFER

Pursuant to 28 U.S.C. §1404(a), plaintiff, on April 25, 1968, filed a motion to remand or retransfer the instant case back to the District Court for the Northern District of Georgia, Atlanta Division. It is the view of the court that to entertain such a determination would be tantamount to reviewing Judge Smith's order of February 1, 1968, thus constituting a usurpation of appellate function and interference with orderly judicial process. *Devex Corp.* v. *General Motors Corp.*, 263 F. Supp. 17, 23 (D.Del. 1967); *Gulf Research & Development Co.* v. *Schlumberger Well Surveying Corp.*, 98 F. Supp. 198, 201 (D.Del. 1951), mandamus denied sub nom. *Gulf Research & Development Co.* v. *Leahy*, 193 F.2d 302 (3d Cir. 1951), aff'd, 344 U.S. 861 (1952).

It is therefore

ORDERED

1. Ex-Cell-O's Motion for Default Judgment filed June 6, 1968, is denied.

2. Collins' Motion for Stay filed May 6, 1968, is denied.

3. Collins' Request to File a Reply to Plaintiff's Reply Memorandum on Motion to Remand or Retransfer filed July 24, 1968, is granted.

4. Technitrol's Motion to Remand or Retransfer filed April 25, 1968, is denied.

August 14, 1968.

EDWARD J. McMANUS
United States District Judge

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF GEORGIA

ATLANTA DIVISION

TECHNITROL, INC., *Plaintiff,* vs. COLLINS RADIO COMPANY, *Defendant.*	CIVIL ACTION NUMBER 11,165

ORDER ON DEFENDANT'S MOTION TO TRANSFER

This is an action for patent infringement in which defendant is charged with infringement of U. S. Patent No. 2,611,813, a "Magnetic Data Storage System."[1] Defendant has moved to transfer this action to the United States District Court for the Northern District of Iowa, Cedar Rapids Division, pursuant to 28 U.S.C.A. §§1404 and 1406.[2]

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[1] A more complete description of the patented apparatus as well as the apparatus which allegedly violates this patent is found at pp. 3-5, 7-9 of Memorandum in Support of Defendant's Motion to Transfer.

[2] 28 U.S.C.A. §1404(a) provides:
For the convenience of parties and witnesses, in the interest of justice, a district court may transfer any civil action to any other district or division where it might have been brought.

28 U.S.C.A. §1406(a) provides:
The district court of a district in which is filed a case laying venue in the wrong division or district shall dismiss, or if it be in the interest of justice, transfer such case to any district or division in which it could have been brought.

Defendant also argues that transfer to the United States District Court in Philadelphia would be proper. See the affidavit of Morris Relson.

At the outset, the court commends the thorough and energetic efforts of counsel in presenting arguments upon the questions raised by the present motion.

The relevant factors to consider in ruling upon a motion for change of venue have been variously and frequently stated. The Court in *Gulf Oil Corp* v. *Gilbert*, 330 U.S. 501 (1947) listed the following factors: (1) private interests of the litigants, (2) relevant ease of access to sources of proof, (3) availability of compulsory process for attendance of unwilling witnesses, (4) cost of obtaining attendance of willing witnesses, (5) possibility of obtaining view of the premises, (6) and all other practical problems that make trial easy, expeditious and inexpensive. These basic principles are discussed in *Pharma-Craft Corp.* v. *F. W. Woolworth Co.*, 144 F. Supp. 298 (M.D. Ga. 1956) *affirmed* 236 F.2d 911 (5th Cir. 1956).[3]

A glance at the notes accompanying 28 U.S.C.A. §1404 in United States Code Annotated demonstrates that the above listing is not exhaustive. Yet it does provide a starting point for a discussion of the particular facts of this case and a delineation of those factors which are controlling.

The proofs as to the ultimate question of infringement are much more readily accessible at Cedar Rapids for there the manufacturing took place and continues to take place. The data relating to manufacture is found there as to the

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[3] The *Gulf Oil* case was decided under the equitable doctrine of forum non conveniens. The statutory provisions of 28 U.S.C.A. §1404(a) substantially altered the rigors of the older doctrine in that transfer is now permitted upon a lesser showing of inconvenience. *Norwood* v. *Kirkpatrick*, 349 U. S. 29 (1955). However, while the relevant factors in making this decision remain essentially the same (Id. at 32), the discretion is wider under the statute. It should be emphasized then that this case does not involve the older doctrine of forum non conveniens but rather the broader provisions of 28 U.S.C.A. §1404(a). Many of the cases cited by plaintiff must be viewed with this distinction in mind. Note for example in this regard, *Gulf Oil Corp.* v. *Gilbert*, 330 U. S. 501 (1947); *Ford Motor* v. *Ryan*, 182 F.2d 329 (2nd Cir.) *cert. denied*, 340 U. S. 851 (1950); *Menendez Rodriguez* v. *Pan American Life Ins. Co.*, 311 F.2d 429 (5th Cir. 1962).

accused system and as to other systems. If the Delta system constitutes an infringement, then it seems apparent that numerous other systems at defendant's plant may be found to be infringing. Moreover, the Collins personnel located in Atlanta will have little if any knowledge of the facts which underlie the real issues in this case. These persons are located in Cedar Rapids. Defendant also emphasizes that the Delta system will provide problems as to availability for inspection; whereas, such will not be the case as to identical systems located in Cedar Rapids and as to the plans for the Delta system. The travel arrangements as between New York and Cedar Rapids as compared to Cedar Rapids to Atlanta and New York to Atlanta have distinctions but in large measure these distinctions are not great. It would be a practical impossibilty to find a forum that is convenient for all the parties. Yet as indicated above, the Iowa forum is much more convenient than Atlanta from the standpoint of both the subject matter of the alleged patent and a large number of obvious witnesses. Philadelphia would be more convenient as to the proof of proper title and proof of plaintiff's development which led to the patent, but is much less convenient on the issue of infringement which appears to be the central concern at this stage. Accordingly, the strong ties to Cedar Rapids when compared with the tenuous connection with this forum both as to the element of convenience of the parties and the separate element of the interests of justice support the transfer to the Cedar Rapids forum. As stated, the strict criteria set forth in *Gulf Oil* v. *Gilbert,* 330 U.S. 501 (1947) and *Ford Motor* v. *Ryan,* 182 F.2d 329 (2nd Cir.) *cert. denied,* 340 U. S. 851 (1950) were significantly relaxed under the new provisions of 28 U.S.C.A. §1404(a). See the excellent discussion in *Norwood* v. *Kirkpatrick,* 349 U. S. 29 (1955). The Court recognizes the importance of the plaintiff's choice of forum in the ordinary case. However, plaintiff's choice has only minimal weight where there is but slight contact with the forum chosen. See Chicago, *Rock Island & Pacific Rd. Co.* v. *Igoe,* 220 F.2d 299 (7th Cir. 1955); *General Felt Prod. Co.* v. *Allen Indus., Inc.* 120 F. Supp. 491 (D.Del. 1954).

Defendant's argument as to improper venue is persuasive on the 28 U.S.C.A. §1404(a) issue. Venue in this action is governed by 28 U.S.C.A. §1400(b) which provides:

> Any civil action for patent infringement may be brought in the judicial district where the defendant resides, or where the defendant has committed acts of infringement and has a regular and established place of business.

Clearly, under this provision, venue would be proper in the Northern District of Iowa. However, there would be some question as to whether defendant has "a regular and established place of business" within the Northern District of Georgia. Defendant employs some 24,000 people with major plants and officers in Iowa, California and Texas. In Atlanta defendant has at most two sales offices, including six salesmen and one secretary. Of significance for the purposes of the Court's ruling is the fact that neither of these offices is engaged with the work relating to the Data Sysems operation, but have concentrated thus far on other products of defendant. In fact, the Delta system is the only known article in this entire district under attack. The fact tends to underscore the remoteness of this forum to the issues of this case. Moreover, there is considerable doubt as to whether acts of infringement have been committed in this district as is required by 28 U.S.C.A. §1400(b). The definition of "acts of infringement" is found in 35 U.S.C.A. §271(a).

> Except as otherwise provided in this Title, whoever without authority makes, uses or sells any patented invention, within the United States during the term of the patent therefor, infringes the patent.

See 1 Moore's Federal Practice ¶0.144[9] at 1633. Defendant's affidavits demonstrate clearly that the sale of the patented product did not occur in this district. In fact the only electronic data processing equipment made by de-

fendant which is located in this district was for an electronic message switching and processing system intended for Delta Airlines. Equipment for that system was sold by defendant to Korda Leasing of Ohio, Inc. in New York. Then Korda leased the system to Delta. Apparently, this leasing transaction occurred outside of Georgia. The equipment in question was manufactured in Iowa and shipped to Atlanta. Plaintiff argues that the completion of the manufacturing process occurred in Atlanta, *i.e.*, the integration of defendant's product with the "Sabre" system by defendant's agents. This contention is not accompanied by supporting authority. A more complete discussion as to the slight showing as to "regular place of business" and "acts of infringement" is not necessary. However, the discussion of these elements should be placed in the proper context. Defendant has urged rather strongly that venue is improper under 28 U.S.C.A. §1406(a). The Court does not deem it necessary to rest this transfer upon that ground and this order should not be construed as a ruling for or against the contention as to improper venue. The Court does indicate that, at best, the showing as to proper venue in this district is extremely tenuous and unpersuasive: The minor nexus with this forum is of significance in the Court's exercise of discretion under 28 U.S.C.A. §1404(a). As was suggested in *Phillips* v. *Baker*, 121 F.2d 752 (9th Cir. 1941), the better course under these circumstances is to remit the parties to a district where there is no doubt as to the venue, before, rather than after, expensive and protracted litigation. A failure to transfer at this time would result in a significant time delay, for initially the parties would have to litigate the question of whether this is a proper forum under 28 U.S.C.A. §1406(a). It should also be noted that the weighted case load of the Northern District of Iowa is substantially lower than that of the Northern District of Georgia. See 1967 Annual Report of the Director, Administrative Office of the United States Courts. This is certainly not a controlling consideration in this case but the likelihood of a speedier trial does merit some weight. See *Olinick & Sons* v. *Dempster Bros., Inc.*,

365 F.2d 439 (2d Cir. 1966); *Ponter* v. *Calmer S. S. Corp.*, 256 F. Supp. 495 (E.D.Pa. 1966). All of these elements—the delay caused by a ruling of the 28 U.S.C.A. §1406(a) problem, the uncertainty as to the ultimate ruling on this question, the crowded calendar in this forum even if plaintiff should meet its burden as to venue as well as the traditional consideration of convenience—all support the Court's decision to transfer this case.

Accordingly, this case is ordered transferred to the Northern District of Iowa and the Clerk is directed to transmit the files forthwith.

IT IS SO ORDERED.

This the 30th day of January, 1968.

SIDNEY O. SMITH, JR.
United States District Judge

COMMENTS ON THE OPINION OF THE COURT OF APPEALS BELOW

It is submitted that the Opinion of the Court of Appeals below contains the following erroneous conclusions which require comment.

> "No attempt was made by Technitrol to obtain reconsideration of the transfer order, to take an interlocutory appeal from the Georgia order under 28 U.S.C.A. § 1292(b), nor was mandamus relief sought from the Fifth Circuit.
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> "• • • We believe that it is highly probable that if Judge Smith had been timely advised of Technitrol's desire to appeal or seek mandamus, he could and would have requested and received a return of the papers from Iowa with an appropriate order of retransfer if such is required. See and compare *Swindell-Dressler Corp.* v. *Dumbauld,* 3 Cir., 308 F. 2d 267; *Panhandle Eastern Pipe Line Co.* v. *Federal Power Comm'n,* 8 Cir., 343 F. 2d 905, 908-09.
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> "In *I-T-E Circuit Breaker Co.* v. *Becker,* 8 Cir., 343 F. 2d 361, we reviewed by mandamus the validity of an order of transfer in a situation where the case had already been transferred to and accepted by the Illinois Federal District Court." (A-3, A-4)

Comment:

As pointed out above (p. 7), the transfer of the case from the Georgia Court to the Iowa Court was completed *prior* to notice to Technitrol. Consequently, the Georgia Court had lost jurisdiction of the case and the procedures suggested by the Court of Appeals below were *not* open to Technitrol. In the *Swindell-Dressler* v. *Dumbauld* case cited by the Court, *Central Rigging* filed two suits in the Western District of Pennsylvania involving related claims,

one against a party *Miller* (No. 257) and one against *Swindell-Dressler* (No. 565). On the motion of Miller, No. 257 was transferred by Judge Dumbauld under Section 1404(a) to the Northern District of West Virginia on November 19, 1961. Two days prior to such transfer, Plaintiff Central filed a motion to consolidate the two cases, which motion was set for hearing on December 18, 1961, but, on December 14, 1961, Judge Dumbauld, without notice to the parties and without a hearing, entered an order consolidating the two cases and transferring *both* cases to the Northern District of West Virginia although neither party to case No. 565 had requested such a transfer. After an exchange of correspondence, Judge Dumbauld requested a return of the papers in No. 257 and obtained them "in a kind of escrow". The Court of Appeals of the Third Circuit, the transferor Circuit, granted a writ of mandamus, first because it held that the Court had lost jurisdiction over case No. 257 when it was transferred on November 19, 1961, so that he had no jurisdiction to enter the order of consolidation of December 14, 1961, and secondly because the order transferring No. 565 was made without notice to the parties. In its Opinion, the Court said:

> "* * * Second we cannot perceive how the court below could regain jurisdiction of 257 simply by having the papers returned to it by the transferee court in escrow or even by having them returned without any limited custodianship. An order of the transferee court retransferring the case would obviously be necessary, and no order was made here by the United States District Court for the Northern District of West Virginia. * * * (p. 273)
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> "In the light of the circumstances we must hold that the Court below when it entered the order of transfer of December 14, 1961 (consolidating the two cases and transferring No. 565) lost jurisdiction and did not enter a valid order of transfer (of case No. 565)." (p. 274)

Thus the decision below is in conflict with the *Swindell-Dressler* decision of the Third Circuit.

The *Panhandle Eastern Pipe Line* case cited by the Court below involved a motion of the Federal Power Commission to dismiss a petition to review and modify an order of the Commission which had been transferred from the Court of Appeals of the Tenth Circuit to the Court of Appeals of the Eighth Circuit for improper venue. The Court denied the petition, saying:

> "* * * There is no specific statutory provision for a transfer under the circumstances here existing, and so the real issue is whether Courts of Appeal have inherent power to transfer a case."

Since this case did not involve any question of transfer under Section 1404(a), it has no relevance to any issue in this case.

The *I-T-E Circuit Breaker* case cited by the Court was one of the more than 1900 famous electrical equipment manufacturers' antitrust cases. Judge Becker, of the Western District of Missouri, issued an order transferring the case under Section 1404(a) to the Northern District of Illinois where other cases were pending involving claims on similar product lines. The Court of Appeals below denied defendant's petition for a writ of mandamus, relying on the proper exercise of discretion by Judge Becker. To the extent that this decision authorizes review on the merits of a transfer order by the Court of Appeals of the transferor District Court after the transfer order had been executed, it is in conflict with the *Swindell-Dressler* case.

In accord with the *Swindell-Dressler* decision are the decisions in *Magnetic Engineering* v. *Dings* (*supra,* p. 18), *Drabik* v. *Murphy* (CA 2, 1957) 246 F. 2d 408, and *In re Southwestern Mobile Homes* (CA 5, 1963) 317 F. 2d 65. in the *Magnetic Engineering* case (*supra,* p. 18), the

Court indicated that it would be fruitless to treat the appeal before it as a petition for mandamus, saying:

> "* * * However, that course would not be effective here, for, if we dismiss the appeal and remand the case to the district court, it will be too late to grant a mandamus, for the cause has been already transferred. * * *" (p. 869)

In the *Drabik* case, defendant's motion for transfer from the Southern District of New York to the Eastern District of Illinois was granted by an order dated April 10, and filed with the Clerk April 11, who mailed the papers on April 15, the papers arriving at the transferee court on April 18. On April 17, plaintiff moved for reargument (reconsideration) and defendant then filed its petition for mandamus to vacate the order of transfer. The Second Circuit Court of Appeals denied the petition, saying:

> "* * * Thus when that motion came on to be heard the District Court for the Southern District of New York had already lost all jurisdiction over the action because the transfer was then complete." (p. 409, quoting with approval from the *Magnetic Engineering* case.)

In the *Southwestern Mobile Homes* case, there was a petition for a writ of mandamus to order the District Court to vacate an order of transfer under Section 1404(a) from the Northern District of Texas to the District of Colorado. The petition was filed four days after the order of transfer and two days after its receipt by the transferee district court. The Fifth Circuit Court of Appeals (the transferor Circuit) denied the petition, saying:

> "* * * Thus when petitioner's motion for leave was filed in this Court, the transfer was complete and the District Court for the Northern District of Texas had already lost jurisdiction." (p. 66)

Thus, the suggestion of the Court of Appeals below that Technitrol should have sought further review of the order of the Georgia Court dated January 30, 1968 (A-3) in the courts of the Fifth Circuit is in conflict with decisions of the Courts of Appeals of the Second, Third, and Fifth Circuits.

It appears from the Opinion of the Court of Appeals below that this asserted failure of Technitrol to seek further review of the order of the Georgia Court in that Court or in the Court of Appeals of the Fifth Circuit was given considerable weight in reaching its decision to deny Technitrol's Mandamus Petition.

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> "* * * No effort was made to invoke our jurisdiction prior to the September 17, 1968, petition for mandamus. This was *more than seven months* after the Georgia transfer order. Such an unreasonable delay standing alone is a sufficient basis for our refusal to exercise our discretionary power to entertain the writ so far as it pertains to relief from the Georgia transfer order." (A-4; emphasis added)

Comment:

The preponderant portion of the seven months delay in filing the Petition below on September 17, 1968, following Judge Smith's Order of January 30, 1968, was not attributable to Technitrol as appears from the following chronology:

> Feb. 8, 1968—Depositions of employees of Delta Airlines were taken by Technitrol pursuant to Notice dated January 10, 1968, to determine the factual basis of Collins' assembly, use, and sale of the accused apparatus in Atlanta, Georgia, which was necessary to complete the proofs of venue of the Action in the Georgia Court. At these depositions, representatives of Delta, on the request of counsel

for Collins, refused to produce the basic sales agreement covering the accused apparatus (Petition, pp. 7-8).

Mar. 4, 1968—Technitrol filed its Motion for an Order to Show Cause why the Delta witness Callison should not produce the basic sales agreement.

Apr. 25, 1968—Technitrol filed its Motion to Remand or Retransfer the Action in the Iowa Court.

May 8, 1968—The foregoing sales agreement was produced by Collins after briefing and hearing of the foregoing Motion to Show Cause by the Court, but before decision by the Court.

Aug. 14, 1968—The Order of Judge McManus denying Technitrol's Motion to Remand or Retransfer was entered.

Sept. 17, 1968—Technitrol's Petition for a Writ of Mandamus was filed in the Court of Appeals below.

Thus, of the alleged seven months delay, nearly four months represented time during which Judge McManus deliberated Technitrol's Motion of April 25, 1968. Necessarily, Technitrol's Petition had to await Judge McManus' Order.

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"In our view, the new grounds asserted and the additional affidavits filed have little bearing upon the issue of transfer of venue under § 1404(a). The new evidence bears almost wholly upon the question of whether venue exists in Georgia. Such new evidence is controverted. As previously pointed out, Judge Smith specifically disclaimed basing the transfer upon improper venue in Georgia. * * *" (A-9)

Comment:

While Judge Smith "disclaimed basing the transfer upon improper venue in Georgia", his Opinion, taken as a whole, makes it clear that his doubt as to the propriety of venue of the Georgia Court was persuadive in reaching his decision, as appears from the following excerpts from his Opinion:

> "• • • The Court recognizes the importance of the plaintiff's choice of forum in the ordinary case. However, plaintiff's choice has only minimal weight where there is but slight contact with the forum chosen. • • • (A-17)
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> "Defendant's argument as to improper venue is persuasive on the 28 U.S.C.A. § 1404(a) issue. • • •" (A-18)
>
> "• • • In fact, the Delta system is the only known article in this entire district under attack. The fact tends to underscore the remoteness of this forum to the issues of this case. Moreover, there is considerable doubt as to whether acts of infringement have been committed in this district as is required by 28 U.S.C.A. § 1400(b). • • • Defendant's affidavits demonstrate clearly that the sale of the patented product did not occur in this district. • • • Defendant has urged rather strongly that venue is improper under 28 U.S.C.A. § 1406(a). The Court does not deem it necessary to rest this transfer upon that ground and this order should not be construed as a ruling for or against the contention as to improper venue. The Court does indicate that, at best, the showing as to proper venue in this district is extremely tenuous and unpersuasive. The minor nexus with this forum is of significance in the Court's exercise of discretion under 28 U.S.C.A. § 1404(a). • • •" (A-18 - A-19)

The additional evidence obtained from the depositions of the Delta witnesses and the basic sales agreement covering the Delta system were put in evidence through affidavits filed with the Iowa Court (PEX 3-1 and 3-2 and attached Exhibits). This evidence establishes the propriety of venue in the Georgia Court beyond any reasonable doubt (Petition, p. 11). Had Judge Smith complied with Technitrol's request to defer decision on the Collins Motion to Transfer until completion of the Delta depositions and the production of the sales agreement wrongfully withheld by Collins, it is only reasonable to expect that he would have reached a different conclusion on the Collins Motion to Transfer.

Because of the foregoing serious errors in the conclusions of the Court of Appeals below on important factors involved in the proceedings in this case, the authority of that decision is greatly weakened.